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Filing date: **07/11/2017**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91234860
Party	Defendant SMASHBURGER IP HOLDER LLC
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Date	07/11/2017
Attachments	Answer to Notice of Opposition and Counterclaim - In-N-Out Burgers v. Smashburger IP Holder LLC.pdf(853902 bytes)

Registrations Subject to the filing

Registration No.	1598825	Registration date	05/29/1990
Registrant	IN-N-OUT BURGERS 4199 CAMPUS DRIVE, 9TH FL IRVINE, CA 92612 UNITED STATES		

Goods/Services Subject to the filing

Class 030. First Use: 1966/00/00 First Use In Commerce: 1966/00/00
All goods and services in the class are requested, namely: HAMBURGER SANDWICHES AND CHEESEBURGER SANDWICHES, FOR CONSUMPTION ON OR OFF THE PREMISES

Grounds for Cancellation

Abandonment	Trademark Act Section 14(3)		
Registration No.	1598826	Registration date	05/29/1990
Registrant	IN-N-OUT BURGERS IN-N-OUT BURGERS 4199 CAMPUS DRIVE, 9TH FL IRVINE, CA 92612 UNITED STATES		

Goods/Services Subject to the filing

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

IN-N-OUT BURGERS, Opposer, v. SMASHBURGER IP HOLDER LLC, Applicant.	Opposition No.: 91234860 Mark: TRIPLE DOUBLE App. No.: 87/236,154 Mark: SMASHBURGER TRIPLE DOUBLE App. No.: 87/236,167 Mark: TRIPLE DOUBLE App. No.: 87/236,287 Mark: SMASHBURGER TRIPLE DOUBLE App. No.: 87/236,287
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ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM

Applicant Smashburger IP Holder LLC (“Applicant”), by and through its counsel, responds and counterclaims as follows to the Notice of Opposition (the “Opposition”).

The first unnumbered paragraph in the Opposition consists of allegations regarding Applicant’s place of business and Opposer’s alleged belief that it will be damaged by registration of the marks TRIPLE DOUBLE and SMASHBURGER TRIPLE DOUBLE (the “Marks”) set forth in Application Serial Nos. 87236154, 87236167, 87236274, and 87236287 (the “Applications”). Applicant admits it is a Delaware limited liability company with a business address at 3900 East Mexico Avenue, Suite 1200, Denver, Colorado 80210. Applicant denies that Opposer will be damaged by registration of the Marks.

Background Information and Opposer’s Marks

1. Applicant lacks sufficient knowledge and information to form a belief as to the truth of the allegations in Paragraph 1 and therefore denies same.

2. Applicant lacks sufficient knowledge and information to form a belief as to the truth of the allegations in Paragraph 2 and therefore denies same.

3. Applicant lacks sufficient knowledge and information to form a belief as to the truth of the allegations in Paragraph 3 and therefore denies same.

4. Applicant lacks sufficient knowledge and information to form a belief as to the truth of the allegations in Paragraph 4 and therefore denies same.

5. Applicant lacks sufficient knowledge and information to form a belief as to the truth of the allegations in Paragraph 5 and therefore denies same.

6. While the records of the United States Patent and Trademark Office (“USPTO”) speak for themselves, Applicant lacks sufficient knowledge and information to form a belief as to the truth of the contents of the USPTO records, and therefore denies the allegations in Paragraph 6.

7. Applicant lacks sufficient knowledge and information to form a belief as to the truth of the allegations in Paragraph 7 regarding establishment of Opposer’s alleged rights in Opposer’s Marks and therefore denies same. The remaining allegations in Paragraph 7 are legal conclusions to which no response is required. To the extent a response is required, Applicant denies all allegations in Paragraph 7.

8. The allegations in Paragraph 8 are legal conclusions to which no response is required. To the extent a response is required, Applicant denies all allegations in Paragraph 8.

9. Applicant lacks sufficient knowledge and information to form a belief as to the truth of the allegations in Paragraph 9 and therefore denies same.

10. Applicant denies the allegations in Paragraph 10.

11. Applicant lacks sufficient knowledge and information to form a belief as to the truth of the allegations in Paragraph 11 and therefore denies same.

12. Applicant lacks sufficient knowledge and information to form a belief as to the truth of the allegations in Paragraph 12 and therefore denies same.

13. Applicant lacks sufficient knowledge and information to form a belief as to the truth of the allegations in Paragraph 13 and therefore denies same.

14. Applicant lacks sufficient knowledge and information to form a belief as to the truth of the allegations in Paragraph 14 and therefore denies same.

15. Applicant lacks sufficient knowledge and information to form a belief as to the truth of the allegations in Paragraph 15 and therefore denies same.

Applicant's Intent-To-Use Application

16. Applicant admits it operates a chain of restaurants specializing in hamburger and cheeseburger sandwiches. Applicant denies the remaining allegations of Paragraph 16.

17. Applicant admits it filed with the USPTO on November 14, 2016 the four intent-to-use applications that are the subject of this Consolidated Opposition. Applicant denies the remaining allegations of Paragraph 17, if any.

18. Applicant admits it filed an intent-to-use application, U.S. Trademark Application Serial No. 87236154 to register the mark TRIPLE DOUBLE in connection with "carry out restaurants; restaurant services; self-service restaurants."

19. Applicant admits it filed an intent-to-use application, U.S. Trademark Application Serial No. 87236167, to register the mark SMASHBURGER TRIPLE DOUBLE in connection with "carry out restaurants; restaurant services; self-service restaurants."

20. Applicant admits it filed an intent-to-use application, U.S. Trademark Application Serial No. 87236274, to register the mark TRIPLE DOUBLE in connection with "sandwiches."

21. Applicant admits it filed an intent-to-use application, U.S. Trademark Application Serial No. 87236287, to register the mark SMASHBURGER TRIPLE DOUBLE in connection with “sandwiches.”

22. Applicant admits the USPTO published for opposition in the *Official Gazette* on April 4, 2017 all four applications referenced in Paragraphs 18-21.

23. Applicant admits the table in Paragraph 23 summarizes Applicant’s four intent-to-use applications (collectively, “Applicant’s Marks”).

24. Applicant admits it is the owner of record of Applicant’s Marks.

25. Applicant denies the allegations of Paragraph 25.

26. While the records of the USPTO and Trademark Trial and Appeal Board (“TTAB”) speak for themselves, Applicant lacks sufficient knowledge and information to form a belief as to the truth of the contents of the USPTO and TTAB records, and therefore denies same.

27. Applicant denies the allegations of Paragraph 27.

28. Applicant denies the allegations of Paragraph 28.

29. Applicant denies the allegations of Paragraph 29.

30. Applicant admits that two of Applicant’s Marks contain the term SMASHBURGER. The remaining allegations of Paragraph 30 are legal conclusions to which no response is required. To the extent a response is required, Applicant denies same.

31. The allegations of Paragraph 31 are legal conclusions to which no response is required. To the extent a response is required, Applicant denies same.

Count One

Likelihood of Confusion, Mistake or Deception, 15 U.S.C. § 1052(d)

32. Applicant denies the allegations of Paragraph 32.

- 33. Applicant denies the allegations of Paragraph 33.
- 34. Applicant denies the allegations of Paragraph 34..
- 35. Applicant denies the allegations of Paragraph 35.
- 36. Applicant denies the allegations of Paragraph 36.
- 37. Applicant denies the allegations of Paragraph 37.
- 38. Applicant denies the allegations of Paragraph 38.
- 39. Applicant denies the allegations of Paragraph 39.
- 40. Applicant denies the allegations of Paragraph 40.
- 41. Applicant denies the allegations of Paragraph 41.

Count Two
Dilution, 15 U.S.C. § 1125(c)

- 42. Applicant denies the allegations of Paragraph 42.
- 43. Applicant denies the allegations of Paragraph 43.
- 44. Applicant denies the allegations of Paragraph 44.
- 45. Applicant denies the allegations of Paragraph 45.

The final unnumbered paragraph of the Opposition consists solely of requests for relief to the Board, to which no response is required. Applicant denies Opposer is entitled to any relief. Applicant denies each and every allegation not expressly admitted herein.

WHEREFORE, Applicant respectfully requests that the Board dismiss this opposition with prejudice and order the Office to issue a Notice of Allowance in connection with the Application.

COUNTERCLAIMS FOR CANCELLATION
OF REGISTRATION NOS. 1598825 AND 1598826 (15 U.S.C. § 1064(3))

- 46. Counterclaim Petitioner Smashburger IP Holder LLC (“Counterclaimant”) is the Applicant in this opposition.

47. Counterclaim Registrant In-N-Out Burgers (“Counterclaim Registrant”) is the Opposer in this opposition.

48. Counterclaimant hereby incorporates by reference the responses contained in Paragraphs 1 through 45 above.

49. Counterclaim Registrant has pleaded and claims ownership of U.S. Trademark Registration No. 1598825 for the mark TRIPLE TRIPLE covering “hamburger sandwiches and cheeseburger sandwiches, for consumption on or off the premises” in Class 30.

50. Counterclaim Registrant has pleaded and claims ownership of U.S. Trademark Registration No. 1598826 for the mark QUAD QUAD covering “hamburger sandwiches and cheeseburger sandwiches, for consumption on or off the premises” in Class 30.

51. Collectively, Registration No. 1598825 for the mark TRIPLE TRIPLE and Registration No. 1598826 for the mark QUAD QUAD are referred to herein as the “TRIPLE/QUAD Marks.”

52. On information and belief, the cheeseburger product that Counterclaim Registrant formerly offered under the name TRIPLE TRIPLE has been rebranded under the mark 3X3.

53. On information and belief, the 3X3 cheeseburger product offered by Counterclaim Registrant is marketed on Counterclaim Registrant’s website under the 3X3 mark and noted on customer receipts as 3X3.

54. On information and belief, Counterclaim Registrant’s 3X3 product is presented to customers in packaging bearing the DOUBLE DOUBLE mark, and such packaging does not include the mark TRIPLE TRIPLE.

55. On information and belief, Counterclaim Registrant is no longer using the mark TRIPLE TRIPLE in commerce and has no intention to resume use.

56. On information and belief, the cheeseburger product that Counterclaim Registrant formerly offered under the name QUAD QUAD has been rebranded under the mark 4X4.

57. On information and belief, the 4X4 cheeseburger product offered by Counterclaim Registrant is marketed on Counterclaim Registrant's website under the 4X4 mark and noted on customer receipts as 4X4.

58. On information and belief, Counterclaim Registrant's 4X4 product is presented to customers in packaging bearing the DOUBLE DOUBLE mark, and such packaging does not include the mark QUAD QUAD.

59. On information and belief, Counterclaim Registrant is no longer using the mark QUAD QUAD in commerce and has no intention to resume use.

COUNT I
Abandonment Based on Non-Use
(15 U.S.C. § 1064(3))

60. Applicant/Counterclaimant hereby incorporates by reference the responses and allegations set forth in Paragraphs 1 through 59 above.

61. For at least the last three years, Counterclaim Registrant has not used the TRIPLE/QUAD Marks in commerce.

62. Counterclaim Registrant has no intent to use the TRIPLE/QUAD Marks in commerce.

63. Counterclaim Registrant has therefore abandoned the TRIPLE/QUAD Marks and the registrations for Counterclaim Registrant's TRIPLE/QUAD Marks must be cancelled in their entirety.

64. Counterclaimant is being damaged by the presence of Counterclaim Registrant's registrations on the Principal Register, as Counterclaim Registrant is asserting these registrations against Counterclaimant in this Opposition proceeding.

WHEREFORE, Counterclaimant respectfully requests that these Counterclaims be granted and that Counterclaim Registrant's Registration Nos. 1598825 and 1598826 be cancelled as set forth above.

This Counterclaim Petition is submitted electronically together with an electronic payment in the amount of \$800. If the fee is found to be deficient for any reason, please charge Deposit Account No. 08-2623.

Dated: July 11, 2017

Respectfully submitted,

/Larry H. Tronco/

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***Attorneys for the Applicant
Smashburger IP Holder LLC***

CERTIFICATE OF SERVICE

I certify that on July 11, 2017, I served a copy of the above **ANSWER TO NOTICE OF
OPPOSITION AND COUNTERCLAIM** by email and U.S. mail to the following:

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